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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/417,266 | 10/12/1999 | SAMUEL GEORGE MAROPIS | 8285/238 | 7233 |

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| EXAMINER |
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FOSTER, ROLAND G

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| ART UNIT | PAPER NUMBER |
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2645

DATE MAILED: 04/23/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/417,266

Applicant(s)

MAROPIS ET AL.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/28/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s).

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

The request filed on Feb. 08, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/417,266 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being

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examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 3-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen et al. (U.S. Patent No. 5,946,380) ("Cohen"), of record.

With respect to claim 1, the following limitations read upon Cohen.

"[P]repaid local telephone services" reads on the abstract.

"[R]eceiving a telephone call from the subscriber" and "identifying a subscriber account in a prepaid local telephone call database for the subscriber based on the telephone number of the subscriber" reads on col. 4, lines 33-37.

"[R]eceiving a value identification code associated with a prepaid local telephone service program" and "determining a period of service for the identified subscriber account" reads on col. 4, lines 42-55 where a dollar amount (value

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identification code) and a time (period of service) are determined. In other words, a dollar value is a "value" that "identifies" and "number" associated with the prepaid service. Since the dollar value (value identification number) exists in the account before the call, the account is prepaid. See also the abstract.

"[M]onitoring the period of service at the prepaid local telephone call database" reads on col. 4, lines 55-59.

"[S]ending termination date information to the subscriber prior to an expiration of the period of service" is a broad limitation and reads on col. 3, lines 43-46 where the "soft-stop option" informs the subscriber that the subscriber's budget has been exceeded which implies the "current" day. The current day can be said to be "date information". The "soft-stop" termination date information is sent to the subscriber "when a budgeted calling monetary amount is about to be exceeded" (col. 3, lines 20-23) for the month. Therefore, the termination date information is sent "prior" to the expiration of the monthly service period. "[W]herein the expiration of the period of service is unrelated to a duration of a subscriber telephone call" reads on col. 3, lines 51-60 where a subsequent subscriber

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telephone call is made whose duration is unrelated to the expiration of the period of service, namely because the monthly service period has already expired due to depleted funds as discussed above.

Claim 8 differs substantively from claim 1 in that claim 8 recites a telephone network that performs the functions equivalent to the methods performed in claim 1. Therefore, see the claim 1 rejection for additional details. Claim 8 also contains the following limitations that read on Cohen.

"[A] prepaid local telephone call service center in communication with at least one local exchange carrier" reads on Fig. 1, call expenditure control server 125 and LEC 52 that would be part of the local exchange carrier (local telephone company).

"[A]n application server having a processor and a subscriber database" reads on Fig. 1, call expenditure control server 125 and control processor 102 and col. 4, lines 35-45.

"[M]eans for monitoring a subscriber service period without monitoring a duration of individual telephone calls and without

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monitoring a dollar value of the individual telephone calls" reads on col. 3, lines 50-60 where the call expenditure server 125 (monitoring means) monitors for incoming calls during the monthly subscriber service period after the budgeted amount has been exceeded. When an incoming subscriber call is detected, the monitoring means prompts the caller that "you have depleted your budgeted balance for the month." However, because the budgeted balance has been depleted, the call expenditure server 125 (monitoring means) does not monitor the duration or dollar value of the call for call budgeting purposes but instead passes the call off to normal telephone billing against the customer's regular telephone account.

With respect to claim 14, the following limitations read upon Cohen.

"[E]stablishing a subscriber account on a prepaid local telephone service database, the subscriber account comprising subscriber identification information and a period of service' reads on col. 3, lines 13-21.

"[M]onitoring the period of service for the subscriber account at the prepaid local telephone service database

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independently of a duration and a dollar value of a subscriber telephone call" reads on col. 4, lines 55-59 and col. 3, lines 50-60 a call expenditure server 125 monitors subscriber calls during the monthly period of service independently of the duration and dollar value of the call during those times when the subscriber's balance is depleted (see the claim 8 rejection for further details).

"[S]ending service termination information to the subscriber prior to an expiration of the period of service" reads on col. 3, lines 20-60 as discussed in the claim 1 rejection above. See also col. 4, lines 64-67.

Claim 16 substantively differs from claim 14 in the claim 16 recites that "a reminder message" is sent to the subscriber prior to expiration which reads on col. 3, lines 20-60 as discussed in the claim 1 rejection above or col. 4, lines 63-67. Therefore, see the claims 1 and 14 rejections for additional details. Claim 16 also recites sending a "suspend message" comprising "an instruction to suspend local telephone service for the subscriber" which reads col. 3, lines 43-47 where the service can be terminated when the balance is empty and restarted if the balance is "replenished" (col. 3, lines 43-47).

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Therefore, the service can be said to be temporarily "suspended" when the balance is empty. The service does not randomly or spontaneously suspend when the balance is empty and restart when the balance is replenished, it must receive instructions to suspend when the balance is empty and to restart when the balance is replenished. The instructions themselves form a message. Therefore, Cohen discloses a suspend message comprising an instruction to suspend local telephone service for a subscriber. If the caller is no longer using the prepaid calling service because the account is fully withdrawn, the account can be said to be "inactive" (no funds withdrawn for prepaid service for long distance calls).

With respect to claim 3, see col. 4, lines 63-67.

With respect to claims 4 and 10, the claim is worded broadly and reads on Fig. 5 where the service is implemented in a Local Exchange Carrier (local telephone company). The message comprising the "hold order" reads on a message inherently required by the LEC to prevent the subscriber from using the service after expiration (col. 3, lines 58-60). Since the service is restarted if the subscriber makes other arrangements for payment (col. 8, lines 35-40), the message can additionally

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be considered as placing the service on "hold" pending other payment arrangements. The message comprising the "hold order" also reads on the actual message sent to the subscriber inviting the subscriber to make other arrangements for the call (col. 8, lines 35-40).

With respect to claims 5 and 11, see col. 3, line 27.

With respect to claims 6 and 12, see col. 3, lines 29-31.

Charging to the regular account during the grace period inherently requires "monitoring".

With respect to claims 7 and 13, see col. 3, lines 31-38 where the grace period ends after the call is completed. On subsequent calls, calls to the prepaid service are blocked (cancel order) until the caller modifies the service. See Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company) which receives a message to block the call.

With respect to claim 9, see col. 3, lines 29-32. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

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With respect to claim 10, see the claim 16 rejection for further details.

With respect to claim 15, as it can best be understood, see the claim 1 rejection for further details.

With respect to claim 17, the "grace period" comprises the time required to start 37 (from when the suspend message is sent) and complete the announcement of col. 3, lines 34-40. The announcement is of a predetermined length. Therefore the grace period can be said to comprise a "predetermined length from when the suspend message is sent. Since the caller is blocked from the prepaid service upon subsequent calls after the suspend message, the caller can be said to be "disconnected" from the service after expiration of the grace period if the subscriber has not modified (renewed) the account subscriber. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claim 1 above, and further

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in view of Taskett (U.S. Patent No. 5,762,376) ("Taskett"), as used in the prior Office action.

Although Cohen teaches the use of a voice response unit (col. 3, line 10), Cohen fails to disclose that voice recognition is used.

However, Taskett discloses of a similar telephone service system with expiration monitoring that uses voice recognition (col. 8, lines 10-15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the voice recognition as taught by Taskett to the voice response unit disclosed by Taskett.

The suggestion/motivation for doing so would have been to increase user-friendliness and flexibility by allowing the subscriber to enter information by speaking in addition to entering information on a telephone keypad. Additionally, the concept of a voice response unit that allows users to either speak or use a telephone keypad, such as "Press or speak 1 for savings" is notoriously well-known in the art.

Allowable Subject Matter

Claim 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Reasons for Allowance

Claim 18 is directed to a method of providing a prepaid local telephone service. A subscriber account is established comprising subscriber identification information and a period of service. The period of service is monitored without monitoring a duration of individual telephone calls and without monitoring a dollar value of individual telephone calls. A reminder message is sent to the subscriber prior to an expiration of the period of server. A suspend message is also sent. The suspend message comprises an instruction to suspend local telephone service for the subscriber and to place the subscriber account on hold in an inactive state. The suspend message also comprises an instruction to permit telephone calls to an emergency telephone number. The subscriber account thereby only permits the subscriber to make telephone calls to the emergency telephone number during the inactive state.

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The closest prior art of record is Cohen as applied above. Cohen teaches of a suspend message but fails to contemplate that the suspend message may comprise an instruction to permit telephone calls to an emergency telephone number so that the subscriber account only permits telephone calls to the emergency number during the inactive state.

Although the prior art teaches of providing free access to a prepaid service when the caller is attempting to make an emergency call, the prior art of record does not teach or fairly suggest the obviousness of adding this feature to the suspend message of Cohen in order to arrive at the invention as claimed in detail by the applicant.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put into a condition for allowance.

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Conclusion

The following prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure.

| <u>U.S. Pat. No.</u> | <u>Date</u> <u>Name</u> | <u>Title/Brief Description</u> |
|----------------------|-------------------------|---|
| 5,870,459 | 2/99 Phillips | RECYCLABLE CELLUULAR TELEPHONE AND METHOD AND APPARATUS FOR SUPPORTING THE USE OF A RECYCLABLE CELLULAR TELEPHONE WITHIN A CELLULAR TELEPHONE NETWORK Prepaid telephone service that sends termination information prior to expiration of period of service and where the expiration of service is unrelated to a duration of a subscriber telephone call (see Fig. 5B and col. 15, line 45 - col. 16, line 15). |

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.

r.g.f. R.S.F.
April 19, 2002

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

